REMARKS/ARGUMENTS

Claim Rejections – 35 U.S.C. § 103

Since all the claims of the present patent application are rejected as being obvious pursuant to 35 U.S.C. § 103(a) and in view of the cited references and since one such alleged prior art reference, namely the U.S. Patent Application Publication No. 2002/0089421 (hereinafter "Farringdon"), is common to the rejection of all the claims, the patentability arguments presented herein will be common for all the pending claims.

In the opinion of the Applicant, the main issue here is the validity of the cited references and more particularly, the citability of the Farringdon reference.

First, § 103(a) reads as follows:

> **35 U.S.C. 103 Conditions for patentability; nonobvious subject matter.**
> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. (emphasis added)

Paragraph §103(a) is clear about the fact that if the difference between an invention and the prior art is so minute that any person skilled in the art would have found it obvious, the invention is not patentable. However, there is one key passage of §103(a): "would have been obvious at the time the invention was made".

Even though it is not determinative in the case of an interference, absent acceptable evidence, the first filing date of an application is deemed as the date with which the priority or the posteriority of certain disclosures can be assessed.

In the present case, the Applicant has filed a patent application in Canada on August 18, 2000, for the same invention which is described in the present U.S. application. Thus, the latest date on which the present invention could possibly have been made is August 18, 2000. Accordingly, to be valid prior art under §103(a), a reference should have been public at least before August 18, 2000.

The Farringdon reference cited by the Examiner was published on July 11, 2002, thus approximately two years after the invention was made. Hence, since the Farringdon reference was not even public knowledge before the invention was made, it is difficult to under understand how a person skilled in the art could have used the knowledge disclosed by Farringdon in 2000 whereas the Farringdon's application was only published in 2002. Accordingly, it is respectfully believed that the Farringdon reference cannot be considered prior art under §103(a).

Moreover, the present U.S. patent application was filed on August 20, 2001, and claimed the benefits of the Canadian patent application filed on August 18, 2000. Thus, even with respect to the American filing date, the Farringdon reference still cannot be considered prior art.

Therefore, since the Farringdon reference cited by the Examiner is not prior art under §103(a) and since it was not publicly available when the present invention was made, the Applicant respectfully requests that the Examiner withdraw her rejections of all the claims based on the Farringdon reference.

Notwithstanding the above, after a closer inspection of the Farringdon reference, it appears that it is the continuation application of U.S. parent application no. 09/747,111, now U.S. Patent No. 6,392,548 (hereinafter, the second Farringdon reference).

The second Farringdon reference was filed on December 21, 2000, and was published on June 28, 2001. Thus, technically, the second Farringdon reference was filed and published before the filing of the present U.S. patent application.

However, the second Farringdon reference still is not prior art for two reasons.

First, when we look at the filing and publication dates of the second Farringdon reference, it still appears that the second Farringdon reference was filed and published after the Applicant's invention was made. It must be borne in mind that §103(a) only specifies that the prior art should be so that the invention would have been obvious at the time it was made and not at the time it was filed. Thus, since the second Farringdon reference was not publicly available and not even filed when the invention was made (before August 18, 2000), it cannot qualify as prior art.

Second, §119(a) reads as follows:

> **35 U.S.C. 119 Benefit of earlier filing date; right of priority.**
>
> (a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing. (emphasis added)

Pursuant to §119(a), since the present U.S. patent application was filed within twelve months of the first Canadian patent application and since the USPTO has acknowledged the claim for foreign priority under 35 U.S.C. §119(a), the present U.S. patent application should be considered, for all intents and purposes, has having been filed on August 18, 2000. However, August 18, 2000, antedates the filing date of the second Farringdon reference which is December 21, 2000. Thus, even with respect to the filing dates, the applicant's U.S. application, pursuant to §119(a), is deemed to have been filed before the second Farringdon reference. Accordingly, even the second Farringdon reference cannot be cited as prior art.

Nevertheless, it might still be argued that both Farringdon references claim the priority of the English Patent Application No. 9930645.8 (hereinafter the English application) and that since the English application was filed on December 23, 1999, thus before the Canadian filing date of August 18, 2000, it qualifies as prior art.

However, after verification of its status on the espacenet web site (http://ep.espacenet.com/?locale=en_EP), the Applicant has found the following statement in the INPADOC legal status tab: "APPLICATIONS TERMINATED **BEFORE** PUBLICATION UNDER SECTION 16(1)". (emphasis added)

Section 16(1) of the English Patent Law reads as follows:

> **Publication of application**
>
> 16.-(1) Subject to section 22 below and to any prescribed restrictions, where an application has a date of filing, then, as soon as possible after the end of the prescribed period, the comptroller shall, unless the application is withdrawn or refused before preparations for its publication have been completed by the Patent Office, publish it as filed (including not only the original claims but also any amendments of those claims and new claims subsisting immediately before the completion of those preparations) and he may, if so requested by the applicant, publish it as aforesaid during that period, and in either event shall advertise the fact and date of its publication in the journal. (emphasis added)

Section 16(1) clearly stipulates that a patent application shall be published as soon as possible following the expiry of the prescribed period unless, for some reasons, the application is withdrawn or refused. Still, from the espacenet website (http://ep.espacenet.com/?locale=en_EP) and more particularly from the INPADOC legal status, it is clear that the English application was not published pursuant to section 16(1). Therefore, even though the English patent application was indeed filed before the Canadian patent application, it was definitively not published before the Canadian filing date. As a matter of fact, the English patent application was never published. Consequently, a reference cannot be considered prior art if it was published after the earliest filing date or worse, if it was never published. In other words, neither the Applicant nor any other person skilled in the art could have used the knowledge contained in the English application at the time the invention was made since the English application was not public at that date.

Accordingly, since neither the first Farringdon reference nor the second Farringdon reference and not even the English application can be used as prior art references in the present case, the Applicant respectfully requests the Examiner to withdraw her rejections of all the claims.

Conclusion

Considering the above arguments, the Applicant respectfully believes that the present patent application is in order and respectfully requests that a timely Notice of Allowance be issued in this case for all pending claims. However, should it be found necessary or practical, the Examiner is kindly invited to telephone the undersigned, Applicant's agent of record, to facilitate the advancement of the present application.

Respectfully submitted,
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Encl: INPADOC legal status of English Patent Application No. GB9930645;

FOR EXAMINER'S INFORMATION

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Legal status (INPADOC) of GB9930645D

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